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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,202	10/17/2001	Darren J. Cepulis	1662-49500 JMH (P98-2413)	5767
22879	7590	02/09/2004	EXAMINER KNAPP, JUSTIN R	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			ART UNIT 2182	PAPER NUMBER 3
DATE MAILED: 02/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/981,202

Applicant(s)

CEPULIS, DARREN J.

Examiner

Justin Knapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Examiner Notes

1. It is hereby acknowledged that the following papers have been received: Change of Address as received 04/07/03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 7, 8, and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Nunn, USPN 6,317,828.
4. Referring to claim 1, Nunn teaches a computer system comprising:
a CPU (figure 1, element 103);
system memory coupled to said CPU (figure 1, element 105) ;
a system ROM containing system ROM code executable by said CPU (figure 1, element 113);
an option device coupled to said CPU (figure 1, elements 120 and 122); and
option ROM code associated with said option device (figure 1, elements 120 and 122);
wherein said system ROM code permits an operator to execute said option ROM code. A BIOS ROM setup code enables the user to control the order of bootable drives that are connected to adapters with option ROMs. An operator permits option ROM code of an adapter execute when

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a drive it is connected to is configured as a bootable drive in the BIOS setup (see figure 2, column 3 through column 5).

5. Referring to claim 2, Nunn teaches wherein said option ROM code is resident on said option device (figure 1, elements 120 and 122).

6. Referring to claim 7, Nunn teaches:

a) configuring one or more aspects of a computer system using system ROM code (figure 1, element 113, Nunn's system has a BIOS ROM setup to configure the system) ;

b) permitting an operator to select an option device coupled to said computer system to be configured using said system ROM code (column 4, various option devices are able to be selected as bootable so they are configured as bootable using the system ROM); and

c) searching for an option ROM code associated with said option device using said system ROM code (column 4, figure 2); and

d) executing said option ROM code (column 4, figure 2).

7. Referring to claim 8, Nunn teaches wherein (c) includes searching for a predefined value that indicates the location of a set of information, said set of information includes a location value that is used to determine the location of the option ROM code. During option ROM scanning operating codes are loaded into memory that contain expansion header information that contains location values for the option ROM codes (column 3 and column 4, lines 38-45).

8. Referring to claim 11, Nunn teaches further including returning to said system ROM code after said option code completes executing. At the end of option ROM initialization and execution, the system returns to the BIOS.

9. Referring to claim 12, Nunn teaches:

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- a) an instruction that permits an operator to configure a computer system (a BIOS Setup ROM permits the configuration of a computer system as taught herein above);
- b) an instruction that permits an operator to configure one or more option devices within the computer system (the BIOS setup permits an operation to configure one or more option devices to be bootable as taught herein above).

10. Referring to claim 13, Nunn teaches further including an instruction which causes an option ROM code associated with an option device to be executed (as taught herein above in rejection of claim 1).

11. Referring to claim 14, Nunn teaches wherein said option ROM code is resident on said option device (as taught herein above in rejection of claim 2).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nunn in view of Zimmer, US Pub 2003/0097581. Nunn does not explicitly teach wherein said option ROM code is copied to and executed from system memory. Nunn does teach a typical adapter device having an option ROM is a SCSI controller. Zimmer teaches that under the prior art, an option ROM is loaded by BIOS into memory and executed (see [0056]). It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to copy and execute option ROM code to system memory in the system of Nunn as taught by the prior art of Zimmer.

Allowable Subject Matter

14. Claims 4, 5, 6, 9, 10, and 16-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Knapp whose telephone number is (703) 308-6132. The examiner can normally be reached on Mon - Fri 9 am - 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Justin Knapp
Examiner
Art Unit 2182

February 4, 2004



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
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